

**REMARKS**

The Official Action mailed May 21, 2003, has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to September 22, 2003. Accordingly, the Applicants respectfully submit that this response is being timely filed.

The Applicants note with appreciation the consideration of the Information Disclosure Statement filed on June 7, 2000, and corrected on August 11, 2000, and October 4, 2000.

The Applicants note the *partial* consideration of the Information Disclosure Statements filed on April 14, 1998, and January 25, 2000. Specifically, with respect to the IDS filed April 14, 1998, and partially considered December 6, 2000, it appears that the Examiner inadvertently overlooked the citation of the Chandani et al. article, "Antiferroelectric Chiral Smectic Phases Responsible for the Tristable Switching in MHPOBC" (Paper No. 14). The Applicants respectfully request that the Chandani article be considered by the Examiner. Accordingly, the Applicants respectfully request that the Examiner provide an initialed copy of the Form PTO-1449 evidencing consideration of the above-referenced Information Disclosure Statement.

With respect to the IDS filed January 25, 2000, and partially considered August 13, 2002, the Examiner asserts that Serial No. 09/781,154 is "not a prior art" (Paper No. 26). Applicants understand that the Examiner has fully considered the '154 application in connection with the subject application. As noted in MPEP § 2001.06(b), the Applicants are under a duty of disclosure which includes copending applications. The Applicants respectfully submit that the IDS filed January 25, 2000, including the reference to the '154 application, fully complies with 37 CFR 1.98 and should be considered by the Examiner. Clarification that the '154 application has been considered by the Examiner is respectfully requested.

Claims 31-33, 38, 39, 46-51, 55-58, 65-67, 69, 83-94, 99, 106-110 and 115-135 were pending in the present application prior to the above amendment, of which claims

38, 39, 83-94, 99, 106-108, 116-119, 122, 123 and 128-132 are withdrawn from consideration. Independent claims 31-33, 67, 69 and 109 have been amended to better recite the features of the present invention. Also, claims 32, 67, 69, 109, 117, 126, 128 and 133-135 have been amended to correct minor typographical errors. Accordingly, claims 31-33, 46-51, 55-58, 65-67, 69, 109, 110, 115, 120, 121, 124-127 and 133-135 are currently elected, of which claims 31-33, 55, 56, 67, 69 and 109 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 2 of the Official Action rejects claims 31-33, 49-51, 55-58, 65-67, 109, 110, 115, 120, 121, 124, 125 and 127 as obvious based on the combination of U.S. Patent No. 4,796,979 to Tsuboyama and U.S. Patent No. 4,775,225 to Tsuboyama et al. Paragraph 3 of the Official Action rejects claims 133-135 as obvious based on the combination of Tsuboyama '979, Tsuboyama '225, and U.S. Patent No. 5,221,980 to Yamamoto et al. With respect to independent claims 31-33, 67, 69 and 109, the Applicants respectfully submit that a *prima facie* case of obviousness cannot be maintained against the independent claims of the present invention, as amended. With respect to independent claims 55 and 56, the Applicants respectfully traverse the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of

one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art.” In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach or suggest all the features of the independent claims. Tsuboyama '979, Tsuboyama '225, and Yamamoto do not teach or suggest a resin disposed between substrates, and a spacer disposed between the substrates.

Independent claims 31-33, 67, 69 and 109 have been amended to recite a resin disposed between first and second substrates, and a spacer disposed between the first and second substrates. Independent claims 55 and 56 recite a column-shape resin disposed between a pair of substrates, and a spacer provided between the substrates. In the present invention, for example, a spacer 8 may be provided between upper and lower resin films 6 and adjacent to resin 21, as seen in Fig. 1. The resin film 21 can prevent destruction of a layer structure in such a manner that a substrate interval is prevented from expanding so as to be kept constant in the case where an area of a display unit is enlarged or the like (see page 21, lines 13-20, and page 24, lines 8-19).

The Official Action concedes that Tsuboyama '979 does not disclose that at least a portion of a resin is contiguous to an orientation film and to a film provided over a second substrate (page 3, Paper No. 33). Tsuboyama '225 appears to disclose “that a resin film can be formed as a spacer (polyimide resin 108) between a pair of substrates (81 and 82)” (Id.). However, Tsuboyama '979 and '225, either alone or in combination, do not teach or suggest a resin disposed between substrates, and a spacer disposed between the substrates. Specifically, spacer 108 in Tsuboyama '225 cannot be relied upon to teach both a resin disposed between substrates, and a spacer disposed between the substrates.

Yamamoto does not cure the deficiencies in Tsuboyama '979 and Tsuboyama '225. The Official Action relies on Yamamoto to allegedly teach that the liquid crystal

layer does not have memory characteristics (page 5, Id.). Tsuboyama '979, Tsuboyama '225, and Yamamoto, either alone or in combination, do not teach or suggest a resin disposed between substrates, and a spacer disposed between the substrates.


Since Tsuboyama '979, Tsuboyama '225, and Yamamoto do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

Paragraph 4 of the Official Action rejects claims 31-33, 38, 39, 49-51, 55-58, 65-67, 69, 109, 110, 115, 120, 121, 124-127 and 133-135 under the doctrine of obviousness-type double patenting over claims 1-4 and 17-19 of U.S. Patent No. 5,594,569 to Konuma et al.

As is discussed in greater detail above, independent claims 31-33, 67, 69 and 109 have been amended to better recite the features of the present invention, and independent claims 55 and 56 recite a feature similar to that recited in claims 31-33, 67, 69 and 109. In light of this amendment, the Applicants respectfully traverse the double patenting ground for rejection. Further, the '569 patent fails to recite that a portion of the resin is contiguous to the orientation film and to the film provided over the second substrate. In addition, the '569 patent fails to recite that the resin has a column shape. Reconsideration of the pending claims is respectfully requested. Reconsideration and withdrawal of the double patenting rejection is requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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